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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/653,595	08/31/2000	Ruth Marie Tritz	25213	4590
23409	7590	06/28/2005	EXAMINER SUBRAMANIAN, NARAYANSWAMY	
MICHAEL BEST & FRIEDRICH, LLP 100 E WISCONSIN AVENUE MILWAUKEE, WI 53202			ART UNIT 3624	PAPER NUMBER

DATE MAILED: 06/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/653,595

Applicant(s)

TRITZ ET AL.

Examiner

Narayanswamy Subramanian

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 26-32 and 40-49 is/are pending in the application.
- 4a) Of the above claim(s) 41-49 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 26-32 and 40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to applicants' communication filed on January 24, 2005. New claims 41-49 have been entered. Claims 1-9, 26-32 and 40-49 are pending in the application. New claims 41-49 are subject to restriction as discussed below. Accordingly, claims 41-49 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03. Applicants in replying to this office action are respectfully advised to cancel the non-elected claims. Claims 1-9, 26-32 and 40 have been examined. The response to amendments, rejections and response to arguments are stated below.

Response to Amendment

2. Newly submitted claims 41-49 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

The claims 1-9, 26-32 and 40 that were examined in the last office action are drawn to a computer-implemented method and a computer-readable medium for automatically evaluating a financial account applicant for a financial institution, the method comprising the acts of: electronically accessing credit bureau data for the applicant; electronically accessing account information for the applicant; electronically generating a score for the applicant based on the credit bureau data and the account information; and determining whether to open the financial account based on the score.

Claims 41-49 are drawn to a method of automatically evaluating a financial account applicant for a financial institution, the method comprising: electronically determining if credit data is available for the applicant; electronically determining if debit data is available for the applicant; electronically accessing account information for the applicant; if only credit data is

Art Unit: 3624

available for the applicant, using a first mathematical process to calculate a score based on the credit data and the account information; if credit data and debit data are available, using a second mathematical process to calculate a score based on the credit data, the debit data and the account information; and determining whether to open the financial account based on the score,

Clearly the limitations of electronically determining if credit data is available for the applicant, electronically determining if debit data is available for the applicant, if only credit data is available for the applicant, using a first mathematical process to calculate a score based on the credit data and the account information; if credit data and debit data are available, using a second mathematical process to calculate a score based on the credit data, the debit data and the account information are not present in the examined claims 1-9, 26-32 and 40. Claims 1-9, 26-32 and 40 and claims 41-49 are related as sub combinations disclosed as usable together in a single combination. The sub combinations are distinct from each other if they are shown to be separately usable. In the instant case, claims 1-9, 26-32 and 40 can be used regardless of whether credit data or debit data is available for an applicant, whereas claims 41-49 can be used only if credit data and/or debit data is available for an applicant. See MPEP § 806.05(d). Because these inventions are distinct for the reasons given above and the search required for examined claims 1-9, 26-32 and 40 is different from that required for new claims 41-49, restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented claims, these claims have been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 41-49 are withdrawn from consideration as being directed to a non-

Art Unit: 3624

elected invention. See 37 CFR 1.142(b) and MPEP § 821.03. Applicants in replying to this office action are respectfully advised to cancel the non-elected claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-9, 26-32 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (US Patent 6,088,686) in view of Basch et al (US Patent 6,119,103) as discussed in paragraph 3 of the office action mailed on October 19, 2004.

Response to Arguments

5. In response to applicant's argument with respect to claim 1 that "Walker does not teach or suggest, among other things, a computer-implemented method of automatically evaluating a financial account applicant for a financial institution", the examiner disagrees. First of all the phrase "a computer-implemented method of automatically evaluating a financial account applicant for a financial institution" is not positively claimed by the applicant but only recited in the preamble. Hence it is not given patentable weight. Secondly the abstract of Walker makes it abundantly clear that Walker discloses this feature (See Walker abstract "The system automates many steps in the credit appropriately completed.)

In reference to Applicant's arguments that Walker does not teach the act of generating a score for the applicant based on the credit bureau data and the account information, the examiner has admitted this in the last office action. However Basch teaches the step of generating a score

Art Unit: 3624

for the applicant based on the credit bureau data and the account information (See Basch Column 5 lines 11-16, 21-29, Column 6 line 64 – Column 8 line 2 and Column 9 lines 24-34). Basch considers credit bureau data (See Basch Column 7 lines 64-66) and account information (See Basch Column 7 lines 15-29) in generating a score. It is amply clear, from the portions of Basch cited above, to one of ordinary skill in the art that the score generated is based on the credit bureau data and the account information.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both Walker and Basch are concerned with providing a financial institution with a tool for analyzing the financial risk of their customers or potential customers (See Walker Column 1 lines 55-67 and Basch Column 3 lines 50-62). Hence it would have been obvious to one with ordinary skill in the art at the time of the current invention to include these steps to the disclosure of Walker. The combination of the disclosures taken as a whole suggests that Financial Institutions would have benefited from the early warnings about the risks associated with opening an account.

In response to applicant's argument about claim 40, Basch teaches the step of generating a score as discussed above. The score is interpreted to include a numerical score.

Art Unit: 3624

In response to applicant's argument about claim 9, a computer-readable medium storing computer-readable instructions for generating a score based on the credit bureau data and the account information is inherent in the disclosure of Basch.

Applicant's other arguments have been considered but are not persuasive.

Conclusion

6. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (571) 272-6751. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (571) 272-6747. The fax number for Formal or Official faxes and Draft to the Patent Office is (703) 872-9306.

Art Unit: 3624

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

N. Subramanian

June 17, 2005

 6/21/05
Jagdish N. Patel
Primary Examiner